

U.S. Application No. 10/722,478
Atty. Docket No. 20435-00144-US

REMARKS

Status of Claims:

Claims 1-19 are pending in the application. Each of the pending claims defines an invention that is novel and unobvious over the cited art. Favorable consideration of this case is respectfully requested.

Disclosure Supporting the Instant Amendment:

Claim 1 is hereby amended to recite: "substantially the absence of exogenous photoinitiators." Support for this recitation was present in the original disclosure at, for example, paragraph 0029, lines 2-4 and paragraph 33, lines 2-4.

Claim 13 is hereby amended to recite: "and the substantial absence of exogenous photoinitiators." Support for this recitation was present in the original disclosure at, for example, paragraph 0029, lines 2-4 and paragraph 33, lines 2-4.

Claim 5 is amended to recite "dicyclohexylmethane diisocyanate," the chemical name for the trade name "Desmodur W" recited in the claims. The amendments are believed not to comprise new matter.

Objection to the Specification:

The specification was objected to for reciting "pendant acrylate groups." The specification is hereby amended to delete the objected to recitation.

Claim Objections:

Claim 5 was objected to as reciting a trade name. Claim 5 is hereby amended to recite the chemical name corresponding to the objected to trade name.

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Rejection Under 35 U.S.C. § 102(b):

Claims 1 and 6-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Nerad (5,641,426)

Rejection under 35 U.S.C. § 102 requires the prior art disclose each and every recitation of the claimed invention.¹ In determining anticipation, no claim recitation may be ignored.² Anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims.³ There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. § 102.⁴ The evidentiary record fails to teach each recitation of the present invention in view of the silence of Nerad regarding the absence of exogenous photoinitiator.

Claims 1 and 13 were amended to more particularly point out the inventive compositions are free of exogenous photoinitiator. In contrast, the thiol-ene system of Nerad comprises a photoinitiator (see col. 6, lines 45-48).

Rejections Under 35 U.S.C. § 103(a):

Claims 1-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nerad in view of Hagstrom (5,578,693),

To establish *prima facie* obviousness of a claimed invention, all the claim recitations must be taught or suggested by the prior art. *In re Royka*.⁵ All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*.⁶ (MPEP § 2143.03). When evaluating the scope of a claim, every recitation in the claim must be considered. See e.g. *In re Ochiai*.⁷ (MPEP § 2144.08). The evidentiary record fails to teach each recitation of the present invention. Specifically, the

¹ See MPEP § 706.02.

² See *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 1871 (Fed. Cir. 1990).

³ See *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986); and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

⁴ See *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

⁵ *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

⁶ *In re Wilson*, 424 F.2d 1382, 165 USPQ 496 (CCPA 1970).

⁷ *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995).

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references taken as a whole or severally fail to teach the absence of exogenous photoinitiator.

As discussed above, Nerad relates to photocuring compositions in the presence of exogenous photoinitiator. The Examiner cites Hagstrom as teaching the monomer components of the oligomers of the present invention. The Examiner does not cite Hagstrom as teaching the absence of exogenous photoinitiator. In fact Hagstrom does not supply the missing teaching because Hagstrom specifically teaches the use of exogenous initiators. (See col. 6, lines 50-54, discussing the use of IRGACURE 184).

Conclusion:

In view of the above, consideration and allowance are respectfully solicited.

Accordingly, it is respectfully requested that the foregoing amendments be entered, that the application as so amended receive an examination on the merits, and that the claims as now presented receive an early allowance.

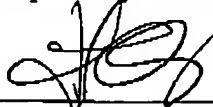
In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

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The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication, including any extension fees or fees for the net addition of claims, to Deposit Account No. 22-0185.

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Respectfully submitted,



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